

REMARKS

By this Amendment, Applicant has amended FIG. 1 and claims 1, 9, 15, and 20. Claims 12 and 16 have been canceled and claims 21-23 have been added. Accordingly, claims 1-11, 13-15, and 17-23 are at issue. Applicant respectfully submits that no new matter was added by this Amendment.

A. Drawings

Per the Examiner's suggestion, FIG. 1 of the Drawings has been amended to designate it as prior art.

B. Rejections Under 35 U.S.C § 112**Claims 7, 14, and 18**

Claims 7, 14, and 18 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The enablement requirement of 35 U.S.C. § 112, first paragraph, is separate and distinct from the description requirement. *Vas-Cath, Inc., v. Mahurkar*, 935 F.2d 1555, 1563; 19 USPQ2d 1111,1116-17 (Fed. Cir. 1991) (the purpose of the written description is broader than to merely explain how to "make and use.") Therefore, the fact that a claim limitation may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled. Consequently, such limitations must be analyzed for both enablement and description using their separate and distinct criteria.

Any analysis of whether a particular claim is supported by the disclosure in an application requires determination of whether that disclosure, when filed, contains sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. Furthermore, when the subject matter is not in the specification portion of the application as filed but is in the claims, the limitation in and of itself may enable

one skilled in the art to make and use the claim containing the limitation. *MPEP* § 2164.

The state of the art existing at the filing date of the application is used to determine whether a particular disclosure is enabling as of its filing date. Additionally, an applicant can offer expert testimony based on a publication as evidence of the level of skill in the art at the time the application was filed. *Gould v. Quigg*, 822 F.2d 1074, 1077 (Fed. Cir. 1987).

The standard for determining whether the specification meets the enablement requirement is whether undue or unreasonable experimentation is needed to practice the invention. *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (Supreme Court 1916). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661; 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). Determining enablement is a question of law based on underlying factual findings — *In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991) — and the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.

The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993). It is incumbent on the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there is no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure. *In re Marzocchi*, 439 F.2d, 220, 224 (CCPA 1971). The examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation.

For the above reasoning, Applicant believes that claims 7, 14, and 18 comply with the enablement requirement of 35 USC § 112. As such, Applicant believes claims 7, 14, and 18 are allowable and respectfully requests the removal of the rejections.

Claim 19

Claim 19 has been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See e.g., *Vas-Cath, Inc., v. Mahurkar*, 935 F.2d at 1563 (Fed. Cir. 1991). There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976) (stating that the court is of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims). The description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439, F.2d 220, 224 (CCPA 1971). Therefore, the examiner must have a reasonable basis to challenge the adequacy of the written description.

The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d at 263 (CCPA 1976). A general allegation is not a sufficient reason to support a rejection for lack of adequate written description. *MPEP* § 2163 (III) (A). In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis that support the lack of written description conclusion — most notably, establishing a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession

of the invention as claimed in view of the disclosure of the application as filed. A lack of adequate written description may arise if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571 (Fed. Cir. 1996). As a general rule however, where software constitutes part of the process of carrying out the invention, the description of such process is satisfied by a disclosure of the function. This is because writing code for such software is within the skill of the art — not requiring undue experimentation — once its function has been disclosed. *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997).

The analysis of whether the specification complies with the written description requirement calls for the examiner to compare the scope of the claim with the scope of the description to determine whether the applicant has demonstrated possession of the claimed invention. *MPEP* § 2163 (II) (A) (2). Such review is conducted from the standpoint of one of skill in the art at the time the application was filed — see, e.g., *Wang Labs. v. Toshiba Corp.* 993 F.2d 858, 865 (Fed. Cir. 1993) — and should include a determination of the field of the invention and the level of skill and knowledge in the art. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563 (Fed. Cir. 1991).

Whether the specification shows that an applicant was in possession of the claimed invention is not a single simple determination, but rather is a factual determination reached by considering a number of factors, i.e., level of skill and knowledge in the art, partial structure, functional characteristics alone or in combination with a known or disclosed correlation between structure and function, etc. Patents and printed publications in the art should be relied upon to determine whether an art is mature and what level of knowledge and skill is in the art. In mature

technologies wherein the knowledge and level of skill in the art is high, a written description question should not be raised for original claims even if the specification discloses only a function of the invention. See, e.g., *In re Hayes Microcomputer Products, Inc. Patent Litigation*, 982 F.2d 1527, 1534-35 (Fed. Cir 1992). Thus, an applicant is not required to describe every detail of the invention. The disclosure obligation varies according to the art to which the invention pertains. For example, disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of § 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out.

For the reasoning set forth above, Applicant believes that claim 19 complies with the written description requirement of 35 USC § 112. Applicant respectfully submits that claim 19 is allowable and requests the removal of the rejection.

Claim 20

Claim 20 has been rejected under 35 U.S.C. § 112, second paragraph, for insufficient antecedent basis. Applicant has amended claim 20 to more distinctly point out and claim the invention. The claim amendment is in accordance with the interpretation of the limitation considered by the Examiner for purposes of examination. Applicant believes that amended claim 20 is now allowable and in accordance with 35 USC § 112, and respectfully requests the removal of the rejection.

C. Rejections Under 35 U.S.C. § 103

Claims 1-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of cited references — Applicant's admitted prior art (AAPA), U.S. Patent No. 5,367,646 to *Pardillos*, U.S. Patent No. 6,049,825 to *Yamamoto*, U.S. Patent No. 5,997,166 to *Flood*, and U.S. Patent No. 6,584,019 to *Chevallier*. Applicant has amended the claims to more distinctly claim the invention and overcome the rejections.

Amended independent claims 1, 9, and 15 of the present application are directed to an apparatus and method of providing an active standby control system. The active standby control system includes a pair of controllers. Each controller comprises an operating state. Among other limitations, the amended claims require a high-speed fiber optic network cable operably connecting the first and second controller wherein Ethernet communication is utilized to facilitate transferring data between the controllers.

Contrastingly, the cited prior art fails to disclose Applicant's claimed invention. There is no disclosure within the cited references directed to a pair of controllers being operably connected by a high-speed fiber optic network cable wherein Ethernet communication is utilized to transfer data there between. Furthermore, none of the cited references teach, disclose, or suggest to modify — alone or in combination — Applicant's claimed invention or the desirability to utilize Ethernet communication for transferring data between the controllers. Consequently, in view of the lack of such disclosure, it cannot be properly asserted that one skilled in the art would make the modification to the cited references to render Applicant's invention obvious. Because there is no suggestion or motivation for Applicant's claimed invention, a *prima facie* case of obviousness cannot be made.

Pardillos et al. discloses a universal device for coupling a computer bus to a controller of a group of peripherals, which are connected to one another by a link to which the controller is connected. *Pardillos et al.* further discloses a known advantage of using fiber optics for increased transmission rate, however, there is no disclosure within *Pardillos et al.* teaching or suggesting Applicant's claimed invention including a pair of controllers — primary and secondary — operably connected by a high-speed cable utilizing Ethernet communication for facilitating data transmission between the controllers. Consequently, in view of the lack of such disclosure, it cannot be properly asserted that one skilled in the art would make the modification to the cited references to render Applicant's invention obvious. Because there is no suggestion or motivation for Applicant's claimed invention, a *prima facie* case of obviousness cannot be made.

Yamamoto discloses a system and method for switching between duplicated network adapters to provide a single host computer with fault-tolerant functionality for TCP/IP communication with a

plurality of other hosts over a network. Analogous to *Pardillos et al.*, *Yamamoto* fails to teach or suggest Applicant's claimed invention including a pair of controllers operably connected via a high-speed cable utilizing Ethernet communication for transmitting data between the controllers. Because of the lack of such disclosure, it cannot be properly asserted that one skilled in the art would make the modification to the cited references to render Applicant's invention obvious. Because there is no suggestion or motivation for Applicant's claimed invention, a *prima facie* case of obviousness cannot be made.

Similarly, *Flood* and *Chevallier* also fail to teach or suggest Applicant's claimed invention including a pair of controllers — primary and secondary — operably connected by a high-speed cable utilizing Ethernet communication to transmit data there between. In view of the lack of such disclosure and because there is no suggestion or motivation for Applicant's claimed invention, it cannot be properly asserted that one skilled in the art would make the modification to the cited references to render Applicant's invention obvious.

The law is clear that the test for obviousness is whether the claimed invention as a whole, would have been obvious to one of ordinary skill in the art at the time the invention was made. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by the Examiner. "[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski et. al.*, 10 U.S.P.Q. 2d 1397, 1398, (Fed. Cir. 1989), *citing*, *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). That motivation cannot come from the Applicants' invention itself. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Thus, unless the references suggest the particular combination of elements themselves, they cannot render Applicants' invention obvious. See *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 USPQ2d 1801, 1817 (N.D. Ill. 1993).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation — either in the references themselves or in the knowledge generally available to one of ordinary skill in the art — to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. And finally, the prior art reference(s) must teach or suggest all of the claim limitations. The Examiner bears the initial burden on factually supporting any prima facie conclusion of obviousness. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner is unable to point to any incentive or motivation in *Pardillos et al.*, *Yamamoto*, *Flood*, or *Chevallier* to make the proposed combination. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (Bold added); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). Merely the fact that Applicant's application — and arguably some of the cited prior art — relate in part to system back-up and network identifiers, e.g., IP and MAC addresses, utilized in a network environment is not an incentive to combine, nor is it a roadmap to combine the selected elements in the manner suggested in the Office Action.

Instead, isolated features from the cited references have been taken and used with the claims of the present application as a template. Such hindsight reconstruction is improper. It is well recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *Fine*, 837 F.2d at 1075 ("one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.")

As set forth above, there is no suggestion or motivation in the cited prior art to make the

proposed combination. Moreover, there is no expectation of success if the references were in fact combined. The Examiner merely concludes Applicant's combination is obvious and fails to show a teaching or motivation in the prior art to combine features of the prior art in the manner suggested in the rejections of claims 1, 9, and 15. *See In Re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (stating, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). The Examiner is required to provide evidence that is clear and particular as to why one skilled in the art would combine the references in the manner suggested. *Id.* (stating, "[t]he range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular."). Instead, the Examiner only provides conclusive statements as to what the prior art would suggest to one of ordinary skill in the art. Such conclusive statements regarding such teaching or motivation are insufficient. *Id.* ("Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'").

Because the cited prior art fails to disclose Applicant's claimed invention, as amended, any modification suggesting Applicant's claimed invention can only be a result of hindsight analysis. Such an analysis is insufficient to present a *prima facie* case of obviousness. Accordingly, Applicant submits that the § 103 rejections of independent Claims 1, 9, and 15 are patentable over the cited prior art.

Claims 2-8, 10-14, and 16-20 respectively depend on claims 1, 9, or 15 — either directly or indirectly — and include each of their respective limitations. Accordingly, based on at least the same reasons given for allowance of claims 1, 9, and 15, Applicant respectfully submits claims 2-8, 10-14, and 16-20 are also patentable and request that the rejections be removed and the claims allowed.

D. Additional Claims

Additional claims 21-23 respectively depend on allowable claims 1, 9, or 15 and include each of their respective limitations. Accordingly, Applicant respectfully submits claims 21-23

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are also patentable and request that these claims be allowed.

CONCLUSION

In view of the amendments and remarks above, Applicant submits that the Application is in condition for allowance. Applicant respectfully requests the Examiner to withdraw the rejections and allow the claims to issue. If any deficiencies remain and it would expedite the progress of this Application through the examination process, the Examiner is invited to call Michael Femal, Esq. at (847) 925-3452.

A check, No. 19445, in the amount of \$18.00 to cover the fees associated with the additional claim is enclosed. Applicant does not believe any additional fees associated with this Response are required, however, the Commissioner is hereby authorized to charge deposit account 19-3875(SAA-52) for any additional fees associated herein.

Respectfully submitted,

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By:



Joseph M. Kinsella Jr., Reg. No. 45,743
WALLENSTEIN WAGNER & ROCKEY, LTD.
311 South Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6630
312.554.3300

Attorneys for Applicant

(190445)